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5642 7590 04/09/2008 SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044				
			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

Office Action Summary

Application No.

09/896,390

Applicant(s)

RODRIGUEZ ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31, 58 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 58, and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/05/2008 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 2/05/2008. Claims **1-31, 58, and 59** are pending. Claim **1** is amended. Claims **32-57** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1, 12, 13, 16, 18, 26-28, and 31**, filed 2/05/2008, have been fully considered, but they are not persuasive.

Regarding claim **1**, the applicant argues that Hunter et al. fails to disclose, teach, or suggest selecting without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content.

The applicant first specifically argues that Hunter et al. fails to disclose, teach, or suggest that the CPU 80 selects without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type. The examiner respectfully disagrees. Hunter et al. discloses storing selected content at a customer's location on DVD's or CD's in a multiple disc platter (p. 1, paragraph 12). The content may be preselected by the user (p. 5, paragraph 65 & p. 8, paragraph 126) or may be automatically downloaded to a customer user station according to the preferences of a user (p. 9, paragraph 141). The user may determine the status of the disc positions of the platter, i.e., what content is currently recorded and stored in the platter and at which disc positions (or "slots"), which disc positions contain blank discs and which disc positions have no discs, such as is shown in Figure 6 (p. 5, paragraph 74 & Fig. 6). Hunter et al. discloses that the disc platter has positions for conventional CD's as well as for DVD's. When music is being recorded, the recording is written to a conventional CD, so that it may be played back on conventional home or auto playback devices. When movie content is being recorded, the recording is written to a DVD (p. 8, paragraph 126). Hunter et al. further discloses the primary controller for the user station is a central processing unit (CPU) 80 that includes a microprocessor, a non-volatile high speed memory device containing an operating system, a graphics generator, and additional peripheral devices, such as a clock, that are common in CPU devices (p. 5, paragraph 64 & Fig. 4). When content is being received, decoder 82 looks for headers in the datastream indicating movies or other content that have been preselected for recording. Decoded preselected content is transmitted via CPU 80 to a high speed memory buffer 84 and then to the platter (p. 5, paragraph 65). CPU 80 also directly receives manual and

infrared remote operation input data and presents the interactive program guide (p. 5, paragraph 70). That is, the CPU 80 controls the functions of the user station. The examiner notes that, even if the user selects the content to be stored, the CPU performs the requested functions “without user intervention,” as currently claimed. That is, the CPU controls the CD or DVD writing operation. Since music content is stored on a particular CD within the platter and movie content is stored on a particular DVD within the platter, the examiner maintains that Hunter et al. meets the limitation of selecting “without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the portable storage medium type,” as currently claimed.

The applicant also specifically argues that Hunter et al. does not disclose or teach selecting a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type ... corresponding to a *category* of the first recordable media content (italicized for emphasis). The examiner respectfully disagrees. As noted above, Hunter et al. discloses storing a music selection on a CD in one of the platter slots and storing a movie selection on a DVD in one of the platter slots (p. 8, paragraph 126). The examiner notes that music and movies are two different categories of media content (see, for example, Figures 5, 6 of Applicant’s specification). As such, the examiner maintains that Hunter et al. meets the limitation of selecting “without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage

mediums corresponding to a category of the first recordable media content,” as currently claimed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., selecting one or more DVD's designated for storing drama movies (whereas other DVD's may be designated for storing sporting events, action movies, or other genres)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims **27** and **28**, the applicant argues that the combination of Hunter et al. and Browne et al. fails to teach, disclose, or suggest authorized access locks having corresponding icons displayed on one of a plurality of screen displays to alert the user to a requirement for authorized access. The examiner respectfully disagrees. As noted in the Office Action mailed 11/05/2007, Browne et al. discloses allowing a user to lock certain stored programs. Locking a program involves selecting a program from the list and marking it as locked. A locked program will not be erased regardless of the program storage mode selected in the program storage option 301 selected in setup page 300. When inadequate unlocked storage in storage section 104 is reached, the multi-source recorder/player 100 preferably alerts the user and presents a list of locked stored programs, preferably in a format similar to stored program list 600, which are causing the storage capacity condition. The user must unlock the necessary amount of storage in storage section 104 before further recording requests may be accommodated (p. 25, paragraph 4; p. 26, paragraph 1; & Fig. 6). Thus, when a user locks a

program, the system is not authorized to erase the program. As such, the examiner maintains that this meets the limitations of “wherein at least one of the recordable media content on the plurality of portable storage mediums located in the storage device has authorized access locks” and “wherein the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert a user to a requirement for authorized access,” as currently claimed.

Regarding claims **12, 13, 16, 18, 26-28, and 31**, the applicant argues that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, and that it would not have been obvious to one of ordinary skill in the art to combine Hunter et al. in view of Hassell et al., LaJoie et al., Browne et al., or Russo. The examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner maintains that it would have been obvious to one of ordinary skill in the art to make the combinations for the reasons stated in the Office Action below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-11, 14, 15, 17, 19-25, 29, 30, 58, 59** are rejected under 35 U.S.C. 102(c) as being anticipated by Hunter et al.

Referring to claims **1** and **17**, Hunter et al. discloses a recordable media content archiving system in a subscriber network (see Abstract), said recordable media content archiving system comprising:

- a memory for storing recordable media content characterizing information (p. 5, paragraph 68);
- a storage device capable of storing a plurality of portable storage mediums, wherein each portable storage medium is one of a plurality of different portable storage medium types (p. 1, paragraph 12 & p. 8, paragraph 126); and
- a processor configured with the memory to:
 - o receive into the memory the characterizing information corresponding to respective recordable media content (p. 5, paragraph 68);
 - o provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content (p. 5, paragraphs 74-76; p. 7, paragraph 118; p. 8, paragraph 126; & Figs. 5, 7);
 - o download the first recordable content via the subscriber network from a server responsive to a first user input selecting an identifier of the first recordable media content from the user interface (p. 5, paragraph 75 & p. 7, paragraph 117; & p. 9, paragraphs 141, 142);

- select without user intervention (the examiner notes that the CPU 80 selects the CD or DVD in the platter for storage)(p. 5, paragraphs 64, 65 & Fig. 4), a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content (the recording platter has positions for holding conventional CD's as well as DVD's. When music content is selected, it is recorded one of the CD's. When movie content is selected, it is recorded to one of the DVD's)(p. 8, paragraph 126), for storing the downloaded first recordable media content (p. 8, paragraph 126); and
- store on the selected at least one of the plurality of portable storage medium types the downloaded first recordable media content, the at least one of the plurality of portable storage mediums corresponding to the category of the first recordable media content (p. 8, paragraph 126).

Referring to claim **2**, Hunter et al. discloses the system of claim 1, wherein the first user input corresponds to a purchase for personal possession of the first recordable media content (the first press of the program selector 54 shows the current playback price of the title)(p. 5, paragraph 75).

Referring to claim **3**, Hunter et al. discloses the system of claim 2, wherein the recordable media content characterizing information is received into the memory periodically (p. 5, paragraph 68).

Referring to claim 4, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to store recordable media content characterizing information corresponding to the first recordable media content on the at least one of the plurality of portable storage mediums corresponding to the category of the first recordable media content (p. 2, paragraph 13 & Fig. 6).

Referring to claim 5, Hunter et al. discloses the system of claim 1, wherein the storing on the at least one of the plurality of portable storage mediums of the downloaded first recordable media content corresponds to an archiving operation (p. 7, paragraphs 117, 118 & p. 8, paragraph 128).

Referring to claim 6, Hunter et al. discloses the system of claim 5, wherein an archive screen with pre-configured categories is presented to a user prior to storing the downloaded first recordable media content on the at least one of plurality of portable storage mediums (Figs. 5, 13, 14).

Referring to claims 7 and 8, Hunter et al. discloses the system of claim 6, wherein a default is presented to the user for a first pre-configured category, the first pre-defined category corresponding to a genre (Comedy is listed first when the user initiates use of the system by turning the system on)(p. 5, paragraph 74 & Fig. 5).

Referring to claim 9, Hunter et al. discloses the system of claim 8, wherein the default presented to the user is a first genre associated with the downloaded first recordable media content (p. 7, paragraph 117).

Referring to claim **10**, Hunter et al. discloses the system of claim 9, wherein the first genre is included in the received characterizing information corresponding to the first recordable media content (p. 5, paragraph 68).

Referring to claim **11**, Hunter et al. discloses the system of claim 10, wherein a second genre is presented to the user that is different than the first genre (Drama, Action, or Documentary)(Fig. 5).

Referring to claim **14**, Hunter et al. discloses the system of claim 6, wherein a second archive screen is configured to enable the user to search for recordable media among the plurality of portable storage mediums on the storage device (p. 5, paragraph 74 & Fig. 6).

Referring to claim **15**, Hunter et al. discloses the system of claim 6, wherein the archive screen is configured to enable the user to search for characterizing information corresponding to the recordable media content among the plurality of portable storage mediums stored on the storage device (p. 5, paragraph 74 & Fig. 6).

Referring to claim **19**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to determine if the at least one of the proper plurality of portable storage mediums is loaded on the storage device p. 5, paragraph 74 & Fig. 6).

Referring to claim **20**, Hunter et al. discloses the system of claim 19, wherein the processor is configured to automatically load the at least one of the proper plurality of portable storage mediums on the storage device (p. 1, paragraph 12 & p. 5, paragraph 74).

Referring to claim **21**, Hunter et al. discloses the system of claim 20, wherein the at least one of the proper plurality of portable storage medium is categorized by title type (Fig. 6).

Referring to claim **22**, Hunter et al. discloses the system of claims 21 and 32, wherein the processor is further configured to load the at least one of the proper plurality of portable storage mediums on the storage device with the title type corresponding to the first recordable media content (p. 5, paragraph 74 & Fig. 6).

Referring to claim **23**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to prompt the user to load the plurality of portable storage mediums on the storage device (Fig. 6).

Referring to claim **24**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to receive the first user input from a remote control device (p. 4, paragraph 52 & Fig. 3).

Referring to claim **25**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to categorize the first recordable media content and the plurality of portable storage mediums by a user providing the first user input (p. 5, paragraph 75).

Referring to claim **29**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to enable a user to categorize recordable media content, and the plurality of portable storage mediums that store the recordable media content, into a structured archive, wherein the processor is further configured to receive the downloaded first recordable media content on at least one of the plurality of different portable storage medium types with characterizing information matching the downloaded first recordable media content (Figs. 13, 14).

Referring to claim **30**, Hunter et al. discloses the system of claim 1, wherein the processor, the memory, and the storage device are located in a set top box (p. 10, 11, paragraph 150).

Referring to claim **58**, Hunter et al. discloses the system of claim 1, wherein the processor is further configured to select without user intervention, a portable storage medium type corresponding to a second category of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content (CDs and DVDs, see claim 1).

Referring to claim **59**, Hunter et al. discloses the system of claim 1, wherein the category includes a subcategory (Fig. 5).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **12**, **13**, **16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of Hassell et al.

Referring to claims **12**, **13**, and **16**, Hunter et al. discloses the system of claims 6 and 11. Hunter et al. does not disclose modifying and editing received characterizing information corresponding to a first recordable media content to include a second genre, personalized categories, or different pre-configured defaults. Hassell et al. discloses allowing a user to modify

program information to enter categories the user wants associated with the program (p. 4, paragraph 45 & Fig. 7b). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the program information in the menu of Hunter et al. to include fields allowing a user to enter user-defined categories, such as that taught by Hassell et al. in order to provide a user with greater control over a user interface.

4. Claims **18, 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of LaJoie et al.

Referring to claim **18**, Hunter et al. discloses the system of claim 1. Hunter et al. does not disclose that the processor is configured to receive the downloaded first recordable media content from the server through an exclusive network session. LaJoie et al. discloses transmitting programs to a subscriber's set-top terminal in the form of a unicast (unicast is the sending of information packets to a single destination (see <http://www.dictionary.com> encyclopedia definition of unicast)) transmission (col. 9, l. 43-52). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hunter et al. to include transmitting programs to a subscriber in the form of a unicast transmission, such as that taught by LaJoie et al. in order to allow a user to access the content as quickly as possible.

Referring to claim **26**, Hunter et al. discloses the system of claim 25. Hunter et al. does not disclose purchasing the first recordable media content prior to downloading the content. LaJoie et al. discloses a user input for purchasing an Impulse Pay-Per-View (IPPV) event for recording (col. 21, l. 42-49). It would have been obvious to one of ordinary skill in the art at the

time that the invention was made to modify Hunter et al. to include a user input for purchasing an event prior recording, such as that taught by LaJoie et al. in order to save storage space.

5. Claims **27, 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of Browne et al.

Referring to claims **27** and **28**, Hunter et al. discloses the system of claim 1. Hunter et al. does not disclose that at least one of the recordable media content on the plurality of portable storage mediums located in the storage device have authorized access locks, wherein the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert a user to a requirement for authorized access. Browne et al. discloses a screen displaying a list of stored programs. Browne et al. further discloses that a user may lock certain listed stored programs, so that the program will not be erased (p. 25, paragraph 4). Browne et al. still further discloses displaying an icon to the user indicated that a program is locked (Fig. 6). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hunter et al. to allow a user to lock a stored program and include icons to alert the user of the locks, such as that taught by Browne et al. in order to provide a more user-friendly interface.

6. Claims **31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of Russo.

Referring to claim **31**, Hunter et al. discloses the system of claim 1. Hunter et al. does not disclose that the processor, the memory, and the storage device are located in a headend.

Russo discloses storing selected program materials in a program storage unit 14, wherein the storage technique employed includes recording data compressed information on arrays of disks or magnetic tapes, including auto-changer facilities to switching between media (col. 4, l. 10-21). Russo further discloses that the program storage unit 14 can be located at either the subscriber site or could be part of a larger storage unit located at the cable transmission facility (col. 4, l. 28-44). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hunter et al. to include a program storage unit 14 at the transmission facility, such as that taught by Russo in order to reduce the cost of a user's set top box.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
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2623

MVH